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IN THE

Supreme Court of the United States

(October Term, 1946)

No. 24.

Halliburton Oil Well Cementing Company, a Delaware corporation, *Petitioner*,

v.

Cranford W. Walker and Cranford P. Walker, D. A. Walker, Robert P. Miller and Milo C. Ketchum, doing business as Depthograph Company, a copartnership, *Respondents*.

REPLY BRIEF FOR HALLIBURTON OIL WELL CEMENTING COMPANY, PETITIONER, ON REARGUMENT BEFORE A FULL BENCH.

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In Respondents' Brief (pages 5 to 15), an agrument is made based upon the commercial success of the Depthograph Company in measuring fluid levels in oil wells. It is said that there was a long-felt want for the invention of the patent in suit and that previous attempts to solve the problem were failures.

Commercial success is not relevant to the question of whether or not the claims of the patent in suit meet with the statutory requirements, nor is it relevant to the question of file wrapper estoppel. "Long felt want" and "commercial success" are relevant only to the question of invention and even then they are not always considered. *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 89 L. Ed. 973; *McClain* v. *Ortmayer*, 141 U. S. 419, 35 L. Ed. 800; *Lovell Mfg. Co.* v. *Cary*, 147 U. S. 623, 37 L. Ed. 307; *Duer* v. *Corbin Cabinet Lock Co.*, 149 U. S. 216, 37 L. Ed. 707.

The statements in Respondents' brief as to commercial success are not correct. There was no long felt want. The prior attempts were successful (R. 258, 259). Respondents themselves were successful before the invention in suit was made. The alleged invention in suit was made March 6, 1937 (R. 196). Prior to that time a number of fluid level determinations were made commercially. [See list of wells tested in 1936, 1937 and 1938 (R. 1256, 1257).]

Walker went into this business after seeing the Lehr and Wyatt apparatus being run. (R. 154, 155, 514, 515).

Lehr and Wyatt were not using a recorder but their patent 2,047,974 (R. 1102), which is prior art, *discloses*, in Figure 2, a microphone, amplifier and recorder. Testimony in this record (R. 290-297, 416-418, 432, 433) shows conclusively that when Petitioner's experts built and operated an apparatus in accordance with Figure 2 of the Lehr and Wyatt patent, it worked successfully and recorded echoes from tubing collars as well as fluid level and other obstructions in a well.

Respondent Walker is not the first to devise means for recording tubing collar echoes. That is inherent in the structure of the prior Lehr and Wyatt patent. Walker is not entitled to a monopoly on the use of the Lehr and Wyatt apparatus for that purpose. In *General Electric Co.* v. *Jewel Incandescent Lamp Co.*, 326 U. S. 242, this Court said:

> "If A, without mentioning the element of strength patented a bulb which was extra strong, B could not obtain a patent on a bulb because of its strength, though he was the first to recognize that feature of it. That is the import of Ansonia Brass & Copper Co. v. Electric Supply Co., 144 U. S. 11, 36 L. Ed. 327. * * * The benefits of the 'potencies and values more important than the uses that were immediately apparent' belong to him who establishes priority of discovery. Radio Corp. of America v. Radio Engineering Laboratories, 293 U. S. 1, 14, 79 L. Ed. 163, 171."

In Respondents' brief, pages 22 to 24, it is argued that the statements in our brief, page 35, are "refuted" by Dr. Mackeown and by Petitioner's instruction manual. It is true that the instruction manual contains an incorrect statement as to the operation of a filter. This manual is not sworn testimony. That the statement in the manual is not correct was stated positively by Dr. Mackeown while he was on the stand (R. 462, 463) and also by Cornes (R. 317-321). Dr. Mackeown did not testify that a filter, *when used as petitioner uses it*, has a period of oscillation corresponding to the frequency of tubing collar echoes. The citation at the bottom of page 22 of Respondents' brief, to the record page 469, is misleading. Dr. Mackeown's answer to counsel's question is separated from the context.

On pages 457 to 468 of the record, Dr. Mackeown testified as to the possibility of *maladjusting* the amplifier-filter circuit of Petitioner's Echo-Meter so as to make it oscillate. Dr. Mackeown testified that this could be done, but that if it were done, the circuit would no longer operate as an amplifier-filter.

Then, on page 469 of the record, cited in Respondents' brief, the following testimony appears:

> "Q. And with the filter set at that same value that we have spoken of in the last few questions, wouldn't the filter then have a natural period of oscillation corresponding to the frequency of the tubing collar echoes?

A. Yes, it would.

The Court: What you mean is that it can be set so that it oscillates and records the tubing collar echoes?

A. Well, maybe I can explain. Let's think of a pendulum in a grandfather's clock. That pendulum is not oscillating, but it has a perfectly natural frequency of oscillation because of its length, and if it starts oscillating, it will oscillate with that frequency. I think what Mr. Mattingly asked in his last question: It is a pendulum not moving, but it has a natural frequency of oscillation because of the structure, and if it does oscillate it will oscillate at the natural frequency."

From this explanation by Dr. Mackeown, it is clear that the filter in Petitioner's circuit never oscillates. It could be made to oscillate, but then it would not be performing the intended function, and it would then not be a filter.

In Respondents' brief, pages 28 and 29, it is averred in italics that "the Patent Office * * * evidenced the intention of the Patent Office that the claims should extend to and cover the very type of apparatus which respondent in this case complains is an infringement of his claims."

There is no support whatever for this assertion. In petitioning the Patent Office to have the application which resulted in the patent in suit made "special", Walker filed an affidavit (R. 1519) and so did his counsel, Mr. Mattingly (R. 1520). Walker's affidavit stated:

> "Affiant further states that he has personally inspected the apparatus employed by the competitors, International Geophysics Inc., and that the same incorporates mechanism for producing pressure waves in wells, mechanism for recording the same, and mechanism for tuning instruments to accent the echoes from tubing collars or similar regularly spaced obstructions in the wells."

Mr. Mattingly's affidavit stated:

> "That, in addition thereto, affiant has carefully compared the evidence submitted to him including the photographs accompanying the said petition and, in

his opinion, the competitor, International Geophysics, Inc., is clearly infringing claims 26, 27 and 28 of this application."

Claim 26 (R. 1454) of the application which was said to be infringed read as follows:

> "In an apparatus for determining the location of an obstruction in a well having a string of assembled tubing sections therein, means communicating with said well for creating a pressure impulse in said well, a pressure responsive device for receiving pressure impulses from the well, a means intercoupling said pressure responsive device with the well and having such effective length as to tune said pressure responsive device to one of the harmonics of echoes of said impulse received from the coupling collars of said tubing string, and means associated with said pressure responsive device for measuring the frequency of said tubing collar echoes and for counting the same and for measuring the lapse of time between the creation of said impulse and the arrival at the pressure responsive device of the echo of the impulse from said obstruction."

Since this claim 26 includes "means intercoupling said pressure responsive device with the well and having such effective length as to tune said pressure responsive device", these affidavits are to the effect that Walker's competitor, International Geophysics, Inc. was using an acoustical resonator of adjustable length.

We do not know whether International Geophysics, Inc. was using an acoustical tuned resonator or not. There is very little in the record about what International Geophysics, Inc. was using.

But these affidavits, far from apprising the Examiner in the Patent Office of the fact that Walker intended to assert this patent against one who was merely using an electrical filter, lulled the Examiner into a belief that the patent would be asserted only against one who was using a device "having such effective length as to tune". Nowhere

in the several applications which Walker filed in the Patent Office is there any mention whatever of the alleged equivalency of a *filter* and an acoustical resonator.

In Respondents' brief, pages 29 to 31, Walker's copending application (Exhibit L, R. 953) on the electrical recording system is discussed. Our entire argument as to claim 15 of that application and the admissions made by Walker as to it, is ignored.

Counsel discuss claim 35 which was presented to the Patent Office after the patent in suit had been granted and which was rejected on the patent in suit. This has nothing whatever to do with the question of file wrapper estoppel.

Petitioner introduces in evidence the file wrapper of the copending application (Exhibit L) to show that the Patent Office refused to grant Walker a patent on the use of a filter in the prior Lehr and Wyatt recording system and that Walker acquiesced in that action.

Respondent seeks to use this exhibit in lieu of testimony by experts on the question of interpretation of the claims in suit.

We submit that the only proper use of Exhibit L is in connection with Walker's admissions.

In connection with the two questions of law here involved, Respondents' brief sets up straw men which are then knocked down. Since other points of law are involved in *General Electric* v. *Wabash*, 304 U. S. 364, and in *Schriber-Schroth* v. *Cleveland Trust Co.*, 311 U. S. 211, than are relied upon by Petitioner, Respondents show that these other points are not applicable here and then argue that those cases are not controlling.

Petitioner is not asking this Court to overrule the decision in *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, nor is it asking that a ruling be made condemning all claims which use the word "means" followed by a statement of function. Petitioner urges that the decision of this Court in *General Electric Co.* v. *Wabash*, citing with approval the decision of the Sixth Circuit Court

of Appeals in the case of *Davis Sewing Machine Co.* v. *New Departure Mfg. Co.*, 217 F. 775, sets forth the law applicable to the facts here and that the use of clauses which are purely functional in claims should be condemned where they are used purportedly to define the exact point of novelty. In other words, claims must distinguish from the prior art by a recitation of structure rather than function, if they are to be valid. This has always been the law. It is the law of *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, the decision there being that the claims defined the exact point of novelty by a recitation of structure and that the functional clauses in the claim were directed to other than the exact points of novelty.

As to the second question of law involved here, Petitioner is not seeking to have a broad patent limited merely because the patentee filed a second application. Petitioner is seeking to have a patent construed in the light of admissions made in a copending case following a rejection *on art which is prior to both*. When Walker cancelled claim 15 of the copending application and admitted (R. 1015) that no invention was involved in placing a filter in the prior Lehr and Wyatt system, he dedicated to the public such rights as he might have had therein. Under the law, nothing that he subsequently did, and nothing that the Examiner subsequently said, can revoke that dedication. Petitioner, or any other member of the public, has as much right to use a filter in the Lehr and Wyatt system as Walker has. This is entirely different from a case where, in an application on an improvement, a rejection is made on the applicant's own prior patent and an assertion is made that the earlier patent is broad. One case is an admission that the public has certain rights. The other is only a contention that the inventor's rights are covered by another patent.

We submit that the claims in suit should be declared invalid under the doctrine of *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, or, if this doctrine does not apply, that the claims be declared not infringed because of

the estoppel arising from the admissions made in the Patent Office, which under the doctrine of *Schriber-Schroth v. Cleveland Trust Co.*, 311 U. S. 211, bar the application of the doctrine of equivalents.

Respectfully submitted,

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